IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Attorney Docket No.: **Poly-32**

Appl. No.: **09/941,072**

Applicants: **David GOODMAN et al.**

Filed: **August 28, 2001**

Title: **TRACKING FILES OF STORAGE MEDIA AND ENABLING USERS TO QUICKLY ASSOCIATE SUCH FILES WITH THE STORAGE MEDIA ON WHICH THEY ARE STORED**

TC/A.U.: **2171**

Examiner: **Etienne Pierre Leroux**

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S I R:

APPEAL BRIEF

Further to the Notice of Appeal filed on July 9, 2004 and granted a date of receipt of July 12, 2004 by the U.S. Patent & Trademark Office, which set a period of response to expire on September 12, 2004, that period being extended two (2) months to expire on November 12, 2004, the Appellant requests that the Board reverse all outstanding grounds of rejection in view of the following.

I. **Real Party In Interest**

The real party in interest is Polytechnic University. An assignment of the above-referenced patent application

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from the inventors to Polytechnic University was recorded in the Patent Office starting at Frame 0254 of Reel 012130.

II. Related Appeals and Interference

There are no related appeals or interferences.

III. Status of Claims

Claims 1-41 are pending. Claims 1-41 stand rejected.

More specifically, claims 1, 2, 5, 7-10, 12-16, 19-24, 26-29, 31-33, 35, 36 and 39-41 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,408,301 ("the Patton patent").

Claims 6, 11, 25 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Patton patent.

Claims 3, 4 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Patton patent in view of U.S. Publication No. 2003/0161614 ("the Yanagihara publication").

Claims 17, 18, 37 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Patton patent in view of U.S. Publication No. 2001/0018356 ("the Cathey publication").

IV. Status of Amendments

All amendments have been entered. No amendments were filed subsequent to the final Office Action mailed on April 8, 2004 (Paper No. 6).

V. Summary of the Invention

Various embodiments of the present invention are summarized below.

One aspect of the present invention concerns a computer implemented method (and apparatus) for use by a read/write machine, for assigning a unique label to a storage medium. In particular, the method may include (a) determining whether or not the storage medium has been assigned a unique volume label and a unique label identifier, (b) if the storage medium has not been assigned a unique volume label and a unique label identifier, then (i) determining a unique label identifier for the storage medium, (ii) determining a unique volume label for the storage medium, (iii) writing the unique volume label onto the storage medium, and (iv) providing a command to generate a label based on the unique label identifier, the label to be associated with the storage medium, and (c) updating a database based on files, if any, added to or deleted from the storage medium. (See, e.g., the right branch of Figure 3, page 17, line 10 through page 18, line 26, Figure 6, and page 25, line 5 through page 26, line 27.)

In at least some embodiments, the database is synchronized with a database on a device apart from the read/write machine. (See, e.g., block 335 of Figure 3, elements 258 and 262 of Figure 2, page 18, lines 22-25, Figure 7, and page 26, line 30 through page 27, line 31.)

In at least some embodiments, the act of determining a unique volume label is based, at least in part, on state information accessible to the read/write machine. (See, e.g., page 19, lines 1-14.)

In at least some embodiments, method may further (d) accept information read from a label associated with the storage medium without reading the storage medium, (e) convert the accepted information into a database key, (f)

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request records from a database instance using the database key, (g) accept records in response to the request, and (h) render information about the accepted records. (See, e.g., the middle branch of Figure 4, page 20, line 15 through page 21, line 10, Figure 8, and page 28, lines 1-32.)

In at least some embodiments, if the storage medium has not been assigned a unique volume label and a unique label identifier, then a label based on the unique label identifier is generated and the generated label is fixed to the storage medium without storing it on the storage medium. (See, e.g., page 18, lines 3-14.)

In at least some embodiments, the label based on the unique label identifier is a bar code label. (See, e.g., page 11, lines 9-14.)

Another aspect of the present invention concerns a computer implemented method (or apparatus) for use by a read/write machine, for matching file parameters with one or more storage media, each of the one or more storage media having an associated label. In particular, the method may include (a) accepting one or more search parameters, (b) generating a query based on the search parameters, (c) accepting one or more records returned in response to the query generated, and (d) rendering information associated with each of the one or more records accepted, the information rendered being related to the label associated with the storage medium storing one or more files identified with the one or more records accepted, wherein the label is provided on the storage medium without storing it on the storage medium. (See, e.g., the right branch of Figure 4, page 21, line 19 through page 22, line 8, Figure 9, and page 29, line 1 through page 30, line 7.)

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In at least some embodiments, if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then a second indicator is generated, where the second indicator can be perceived by humans. (See, e.g., page 22, lines 8-13 and page 30, lines 2-7)

To summarize the foregoing, various embodiments of the present invention may be used to (i) associate a label, such as a bar code label, with a storage medium and (ii) associate the label with the contents of the storage medium. In this way, given a storage medium, a user can determine its contents, without needing to read the storage medium, by reading the label. Similarly, given a file, a user can determine the label of the storage medium on which the file is stored. The labels of various storage media can be quickly read, and an indication of whether or not the storage medium includes the file can be provided to a user.

VI. Issues

The issues presented for review are whether (separately patentable groups of) claims:

1, 2, 5, 7-10, 12-16, 19-24, 26-29, 31-33, 35, 36 and 39-41 are anticipated, under 35 U.S.C. § 102(e), by the Patton patent;

6, 11, 25 and 30 are unpatentable, under 35 U.S.C. § 103(a), over the Patton patent;

3, 4 and 34 are unpatentable, under 35 U.S.C.
§ 103(a), over the Patton patent in view of the
Yanagihara publication; and

17, 18, 37 and 38 are unpatentable under 35 U.S.C.
§ 103(a), over the Patton patent and the Cathey
publication.

VII. <u>Grouping of Claims</u>

The claims do not stand or fall together.

For purposes of this Appeal, Appellant proposes the
following grouping of claims:

Group I: Claims 1, 5, 9, 20, 24 and 28 are grouped
together with claim 1 being selected as the single
claim from the group upon which the appealed ground of
rejection should be decided. Accordingly, claims 1,
5, 9, 20, 24 and 28 stand together.

Group II: Claims 2 and 21-23 are separately grouped
with claim 2 being selected as the single claim from
the group upon which the appealed ground of rejection
should be decided. Although the claims of Group II
are subject to the same rejection as the claims of
Group I, these claims are separately patentable from
the claims of Group I because representative claim 2
further recites synchronizing the database with a
database on the device apart from the read/write
machine. This separately patentable feature is
discussed in the Argument section below. Accordingly,
claims 2 and 21-23 stand together.

Group III: Claims 7, 8, 26 and 27 are separately grouped with claim 7 being selected as the single claim from the group upon which the appealed ground of rejection should be decided. Although the claims of Group III are subject to the same rejection as the claims of Groups I and II, these claims are separately patentable from the claims of Groups I and II because representative claim 7 further recites that the act of determining a unique volume label is based, at least in part, on state information accessible to the read/write machine. This separately patentable feature is discussed in the Argument section below. Accordingly, claims 7, 8, 26 and 27 stand together.

Group IV: Claims 10, 12-14, 29 and 31-33 are separately grouped with claim 10 being selected as the single claim from the group upon which the appealed ground of rejection should be decided. Although the claims of Group IV are subject to the same rejection as the claims of Groups I-III, these claims are separately patentable from the claims of Groups I-III because representative claim 10 further recites accepting information read from the unique label identifier associated with a storage medium without reading the storage medium and converting such information into a database key. These separately patentable features are discussed in the Argument section below. Accordingly, claims 10, 12-14, 29 and 31-33 stand together.

Group V: Claims 15, 16, 19, 35, 36 and 39 are
separately grouped with claim 15 being selected as the
single claim from the group upon which the appealed
ground of rejection should be decided. Although the
claims of Group V are subject to the same rejection as
the claims of Groups I-IV, these claims are separately
patentable from the claims of Groups I-IV because
representative claim 15 further recites rendering
information associated with each of one or more
records accepted, the information rendered being
related to a label provided on a storage medium
without storing it on the storage medium, wherein the
storage medium stores one or more files identified
with the one or more records accepted. This
separately patentable feature is discussed in the
Argument section below. Accordingly, claims 15, 16,
19, 35, 36 and 39 stand together.

Group VI: Claims 40 and 41 are separately grouped
with claim 40 being selected as the single claim from
the group upon which the appealed ground of rejection
should be decided. Although the claims of Group VI
are subject to the same rejection as the claims of
Groups I-V, these claims are separately patentable
from the claims of Groups I-V because representative
claim 40 further recites that if the storage medium
has not been assigned a unique volume label and a
unique label identifier, then further (i) generating a
label based on the unique label identifier, and (ii)
fixing the generated label to the storage medium
without storing it on the storage medium. This
separately patentable feature is discussed in the

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Argument section below. Accordingly, claims 40 and 41
stand together.

Group VII: Claims 6, 11, 25 and 30 are separately
grouped with claim 6 being selected as the single
claim from the group upon which the appealed ground of
rejection should be decided. Claim 6 includes the
separately patentable feature that the unique label
identifier is a barcode label. This feature is
discussed in the Argument section below. Further,
claim 6 is separately patentable from the claims of
Groups I-VI, as evidenced by the separate ground of
rejection used by the Examiner. Accordingly, claims
6, 11, 25 and 30 stand together.

Group VIII: Claims 3, 4 and 34 are separately grouped
with claim 3 being selected as the single claim from
the group upon which the appealed ground of rejection
should be decided. Representative claim 3 is
separately patentable from the claims of Groups I-VI,
as well as the claims of Group VII, as evidenced by
the separate ground of rejection used by the Examiner.
Accordingly, claims 3, 4 and 34 stand together.

Group IX: Claims 17, 18, 37 and 38 are separately
grouped with claim 17 being selected as the single
claim from the group upon which the appealed ground of
rejection should be decided. This separately
patentable feature is discussed in the Argument
section below. Further, claim 17 is separately
patentable from the claims of Groups I-VI, as well as
the claims of Groups VII and VIII, as evidenced by the

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separate ground of rejection used by the Examiner.

Accordingly, claims 17, 18, 37 and 38 stand together.

VIII.   Argument

The Appellant respectfully requests that the Board reverse the final rejection of claims 1-41 in view of the following.

REJECTIONS UNDER 35 U.S.C. § 102

Claims 1, 2, 5, 7-10, 12-16, 19-24, 26-29, 31-33, 35, 36 and 39-41 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,408,301 ("the Patton patent"). The Appellant respectfully requests that the Board reverse this rejection in view of the following.

Before addressing at least some of the patentable features of the present invention, the Patton patent is introduced. The Patton patent concerns storing, indexing and retrieving images. More specifically, the Patton patent concerns "albuming" images and/or audio. Each of the images may be associated with Metadata, which is information associated with the image. (See, e.g., the Abstract and column 4, lines 20-39.) Thumbnail images, referred to as "Picons" in the Patton patent, may be used to represent a group of images, video, etc. (See, e.g., column 8, lines 51-67.) The images may have been recorded on a DVD provided in a camera. (See, e.g., Figs. 1-3.) A master index directory may use Picons and/or other Metadata to organize the images. This master index directory may be provided independent of the storage media and may have a disk ID and address pointers for indexed sequences of

images. (See, e.g., Column 5, lines 3-5.) As can be
appreciated from the foregoing, the Patton patent concerns
using Metadata, such as Picons for example, to organize
(e.g. index) images.

Group I: Claims 1, 5, 9, 20, 24 and 28

Independent claim 1 is not anticipated by the Patton
patent because the Patton patent does not describe
determining whether or nor a storage medium has been
assigned a unique label identifier, and if not, determining
a unique label identifier for the storage medium and
providing a command to generate a label, based on the
unique label identifier, to be associated with the storage
medium. Representative claim 1 of Group I is reprinted
below with this feature depicted in bold typeface:

> 1. For use by a read/write machine, a
> method for assigning a unique label to
> a storage medium, the method
> comprising:
> > a) **determining whether or not the
> > storage medium has been assigned** a
> > unique volume label and **a unique
> > label identifier;**
> > b) **if the storage medium has not
> > been assigned a** unique volume
> > label and a **unique label
> > identifier,** then
> > > (i) **determining a unique
> > > label identifier for the
> > > storage medium,**
> > > (ii) determining a unique
> > > volume label for the storage
> > > medium,
> > > (iii) writing the unique
> > > volume label onto the storage
> > > medium, and

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> (iv) **providing a command to generate a label based on the unique label identifier, the label to be associated with the storage medium**; and
> c) updating a database based on files, if any, added to or deleted from the storage medium.
> [Emphasis added.]

The Examiner contends that (i) storage media that may be used by a camera discussed on column 3, lines 53-61 of the Patton patent determines whether or not the storage medium has been considered before, (ii) a picture index memory discussed on column 3, line 61 determines a unique label identifier, (iii) a disk ID teaches a unique volume label, (iv) writing Picons teaches writing a unique volume label onto the storage medium, and (v) touch screen operation controls teach proving a command to generate a label based on a unique label identifier. (See Paper No. 6, page 3.)

The applicants respectfully disagree with a number of the Examiner's contentions. First, it is unclear how a listing of storage media that may be used with a camera teaches determining whether or not a storage medium has been considered before, and relevant to the claims as amended, determining whether or not the storage medium has already been assigned a unique volume ID and a unique label ID. Accordingly, claim 1 is not anticipated by the Patton patent for at least this reason. Since independent claim 20 includes means for performing a similar act, it is similarly not anticipated by the Patton patent for at least this reason. Since claims 5, 9, 24 and 28 also include this feature by virtue of their dependency from claim 1 or

claim 20, they are similarly not anticipated by the Patton patent.

In response to the foregoing reason for allowability, the Examiner contends that the Appellant is relying on features not recited in the rejected claims. (See Paper No. 6, pages 16 and 17.) The Appellant disagrees and invites the Board to review claim 1 (and particularly the highlighted portions), reprinted above.

Second, the during a telephone interview, the Examiner confirmed that his position is that Picons of the Patton patent teach the claimed "unique label identifier" of the claimed invention. Although Picons are stored on the storage medium of the Patton patent, they are not generated "if the storage medium has not been assigned a unique volume label and a unique label identifier." Further, Picons are not determined for a storage medium. Rather, they are determined for images or sets of images. Accordingly, claim 1 (and the rest of the claims of Group I) is not anticipated by the Patton patent for at least this additional reason.

In response to the foregoing additional reason for allowability, the Examiner contends that since the Appellant does not particularly point to the specification for an explicit definition of the term "unique label identifier", he will give this term its broadest reasonable interpretation. The Examiner concludes that (i) the picture index teaches the claimed "unique label identifier," and (ii) writing a unique volume label if one has not already been assigned is inherent because "there is nothing in the Patton patent to suggest that duplicate volume labels are created." (See Paper No. 6, pages 17 and 18.) The Appellant first notes that a "volume label" is

not the same as the "unique label identifier," one skilled
in the art would appreciate from the specification. More
specifically, the specification states:

> Then, as indicated by blocks 320 and
> 325, **the unique volume label is written
> onto the storage medium, and a command
> to print (or otherwise generate) a
> unique label associated with the
> storage medium is generated**. Referring
> back to Figure 2, **this command may be
> passed to the label generation
> operation 224. The user may then
> associate the printed unique label with
> the storage medium** (e.g., by affixing
> it to a so-called "jewel-box" case or
> cartridge used to hold the storage
> medium). Alternatively, the unique
> label may be automatically associated
> with the storage medium (i.e., without
> (further) user intervention) in another
> way. [Emphasis added.]

Page 18, lines 3-14. The specification also states:

> In the following, the term "**unique
> volume label**" **uniquely identifies a
> storage medium, and may be written onto
> the storage medium**. Therefore, if the
> storage medium is a diskette, the
> unique volume label may be a unique
> label written onto the diskette by a
> floppy disk drive, and that may be
> subsequently read by a floppy drive.
> **The term "label" also uniquely
> identifies a storage medium, but is
> associated with (e.g., affixed to) the
> storage medium**. Therefore, if the
> storage medium is a diskette, the label
> may be a bar code label affixed to the
> case of the diskette, and that may be
> subsequently read by a bar code reader.
> Although the unique volume label, and
> the label of a given storage medium may

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be the same, or encode the same
information, this is not necessarily
the case.   [Emphasis added.]

Page 17, lines 10-23.

In his rejection, the Examiner improperly assigns a
broadest _possible_ interpretation to "unique label
identifier" (which is used to generate a label to be
associated with the storage medium) -- not the broadest
reasonable interpretation.   Further, the Examiner's
interpretation of "unique label identifier" is inconsistent
with the specification and is inconsistent with the
interpretation that those skilled in the art would reach,
as can be appreciated from the foregoing excerpts from the
specification.

Clearly, this Board and the courts had the foresight
to avoid such unrestrained interpretations when they
required the broadest **reasonable** interpretation, consistent
with both the specification and the understanding of one
skilled in the art.   (See, e.g., MPEP 2111 and In re. Baker
Hughes, Inc., 55 U.S.P.Q.2d 1149, 1152-4 (Fed. Cir. 2000).)

Group II: Claims 2 and 21-23

Since claims 2 depends from claim 1 (and since claims
21-23 depend, either directly or indirectly, from claim
20), the claims of Group II are not anticipated by the
Patton patent for at least the same reasons as discussed
above with reference to the claims of Group I.   Moreover,
representative dependent claim 2 further distinguishes the
present invention since it recites synchronizing the
database with a database on the device apart from the

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read/write machine. Claim 2 is reprinted below with this feature depicted in bold typeface:

> 2. The method of claim 1 further
> comprising:
>   d) **synchronizing the database**
>   **with a database on a device apart**
>   **from the read/write machine**.
>   [Emphasis added.]

The Examiner contends that obtaining location information (from GPS) teaches synchronizing a database with a database on a device apart from the read/write machine. (Paper No. 6, page 3.) Database synchronization is understood by those skilled in the art as making one instance of a database conform to another instance of the database. The applicants fail to appreciate how determining a position teaches synchronizing a database. Accordingly, dependent claim 2 is not anticipated by the Patton patent for at least this additional reason. Since independent claim 21 recites a similar feature, it is similarly not anticipated by the Patton patent. Since claims 22 and 23 depend from claim 21, these claims are similarly not anticipated by the Patton patent.

In response to the foregoing additional reason for allowability, the Examiner contends that the fact that database synchronization is understood by those skilled in the art as making one instance of a database conform to another instances of the database is not recited in the rejected claims. (Paper No. 6, page 18.) However, the broadest reasonable interpretation *must be consistent with both the specification and the understanding of one skilled in the art*. Thus, the Appellant is not trying to read a limitation into the claim, but merely pointing out how

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"synchronizing" a database with another database is be interpreted, and reasonable limits on how broadly it can be interpreted.

Group III: Claims 7, 8, 26 and 27

Since claim 7 depends from claim 1 (and since claim 26 depends from claim 20, and claims 8 and 27 depend from claims 7 and 26, respectively), the claims of Group III are not anticipated by the Patton patent for at least the same reasons as discussed above with reference to the claims of Group I. Moreover, representative dependent claim 7 further distinguishes the present invention since it recites that the act of determining a unique volume label is based, at least in part, on state information accessible to the read/write machine. Claim 7 is reprinted below with this feature depicted in bold typeface:

> 7. The method of claim 1 **wherein the act of determining a unique volume label is based, at least in part, on state information accessible to the read/write machine.** [Emphasis added.]

The Examiner contends that using a touch screen display to view Picons or icons, view video sequences, view still images or groups of still images, etc. teaches determining a volume label based, at least in part, on state information accessible to the read/write machine. (See Paper No. 6, page 3.) Earlier, the Examiner contended that the disk ID of the Patton patent teaches a volume label. (See Paper No. 6, page 3.) The applicants

respectfully submit that viewing various items using a
touch screen does not teach determining a disk ID.
Accordingly, claims 7 is not anticipated by the Patton
patent for at least this additional reason. Since claim 26
includes a similar recitation, it is similarly not
anticipated by the Patton patent. Since claims 8 and 27
depend from claims 7 and 26, respectively, these claims are
similarly not anticipated by the Patton patent.

Group IV: Claims 10, 12-14, 29 and 31-33

Since claim 10 depends from claim 1 (and since claim
29 depends from claim 20, and claims 12-14 depend, either
directly or indirectly from claim 10, and claims 31-33
depend from claim 29), the claims of Group IV are not
anticipated by the Patton patent for at least the same
reasons as discussed above with reference to the claims of
Group I. Moreover, representative dependent claim 10
further distinguishes the present invention since it
recites accepting information read from the unique label
identifier associated with a storage medium without reading
the storage medium and converting such information into a
database key. Claim 10 is reprinted below with these
features depicted in bold typeface:

> 10. The method of claim 1, further
> comprising:
>> d) **accepting information read
>> from a label associated with the
>> storage medium without reading the
>> storage medium;**
>> e) **converting the accepted
>> information into a database key;**

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f) requesting records from a
database instance using the
database key;
g) accepting records in response
to the request; and
h) rendering information about
the accepted records. [Emphasis
added.]

The Examiner cites the use of a master picture
directory having address pointers for indexed sequences as
teaching this feature. (See Paper No. 6, page 4, which
cites column 5, lines 6-8 of the Patton patent.) Although
the Patton patent describes that the master picture
directory can be independent from the master picture
directory, it apparently uses a disk ID (which the Examiner
earlier contended is a unique volume label), not a unique
label identifier associated with the storage medium (which
the Examiner earlier contended was taught by a Picon).

Accordingly, claim 10 is not anticipated by the Patton
patent for at least this reason. Since claim 29 recites a
similar feature, it is similarly not anticipated by the
Patton patent. Since claims 12-14 depend, either directly
or indirectly from claim 10, and since claims 31-33 depend
from claim 29, these claims are similarly not anticipated
by the Patton patent.

Moreover, claim 10 recites accepting information read
from a label associated with the storage medium **without**
reading the storage medium. This recitation was not
addressed by the Examiner. Accordingly, claim 10 is not
anticipated by the Patton patent for at least this reason.
Since claim 29 recites a similar feature, it is similarly
not anticipated by the Patton patent. Since claims 12-14
depend, either directly or indirectly from claim 10, and

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since claims 31-33 depend from claim 29, these claims are similarly not anticipated by the Patton patent.

In response to the foregoing additional reason for allowability, the Examiner contends that the Appellant is relying on features not recited in the rejected claims. (See Paper No. 6, page 19.) The Appellant disagrees and invites the Board to review claim 10 (and particularly the highlighted portions), reprinted above.

Group V: Claims 15, 16, 19, 35, 36 and 39

Representative independent claim 15 is not anticipated by the Patton patent because the Patton patent does not describe rendering information associated with each of one or more records accepted, the information rendered being related to a label provided on a storage medium without storing it on the storage medium, wherein the storage medium stores one or more files identified with the one or more records accepted. Claim 15 is reprinted below with this feature depicted in bold typeface:

> 15. A method for matching file parameters with one or more storage media, each of the one or more storage media having an associated label, the method comprising:
>
>> a) accepting one or more search parameters;
>>
>> b) generating a query based on the search parameters;
>>
>> c) accepting one or more records returned in response to the query generated;

> d) **rendering information
> associated with each of the one or
> more records accepted, the
> information rendered being related
> to the label associated with the
> storage medium storing one or more
> files identified with the one or
> more records accepted, wherein the
> label is provided on the storage
> medium without storing it on the
> storage medium.** [Emphasis added.]

The Examiner contends that the voice actuated image and audio albuming feature of the Patton patent, in which a voice input can be used to access stored images, teaches rendering information associated with each of one or more records accepted, the information rendered being related to a label associated with the storage medium which stores one or more files identified with the one or more records accepted. (See Paper No. 6, page 5.) However, independent claim 15 recites that the label is provided on the storage medium without storing it on the storage medium, which further distinguishes it over the Patton patent. Accordingly, claim 15 is not anticipated by the Patton patent. Since claim 35 recites a similar feature, it is similarly not anticipated by the Patton patent. Since claims 16 and 19 depend from claim 15 and since claims 36 and 39 depend from claim 35, these claims are similarly not anticipated by the Patton patent.

In response to the foregoing additional reason for allowability, the Examiner contends that the Appellant is relying on features not recited in the rejected claims. (See Paper No. 6, pages 19 and 20.) The Appellant disagrees and invites the Board to review claim 15 (and particularly the highlighted portions), reprinted above.

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Group VI: Claims 40 and 41

Since claim 40 depends from claim 1 (and since claim 41 depends from claim 20), the claims of Group VI are not anticipated by the Patton patent for at least the same reasons as discussed above with reference to the claims of Group I. Moreover, representative dependent claim 40 further distinguishes the invention since it recites that if the storage medium has not been assigned a unique volume label and a unique label identifier then further, (i) generating a label based on the unique label identifier, and (ii) fixing the generated label to the storage medium without storing it on the storage medium. Claim 40 is reprinted below with this feature depicted in bold typeface:

> 40. The method of claim 1 **wherein if the storage medium has not been assigned a unique volume label and a unique label identifier then further,**
> **- generating a label based on the unique label identifier, and**
> **- fixing the generated label to the storage medium without storing it on the storage medium**. [Emphasis added.]

The Examiner apparently contends that touch screen operation and indexing controls, and record/capture operations in Figure 1 of the Patton patent teach this feature. (See Paper No. 6, pages 2 and 3). The Appellant fails to see how touch screen controls and record/capture operations teach the acts recited in claim 40. Thus, claim

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40 is not anticipated by the Patton patent for at least the foregoing reason. Since claim 41 includes a similar recitation, it is similarly not anticipated by the Patton patent.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 6, 11, 25 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Patton patent. The Appellant respectfully requests that the Board reverse this rejection in view of the following.

Group VII: Claims 6, 11, 25 and 30

Representative claim 6 is not rendered obvious by the Patton patent because it recites that the label based on the unique label identifier is a bar code label, and because one skilled in the art would not have been motivated to modify the Patton patent, as described by the Examiner, to provide a bar code label as a label based on a unique label identifier. Claim 6 is reprinted below with this feature depicted in bold typeface:

> 6. The method of claim 1 **wherein the label based on the unique label identifier is a bar code label**.
> [Emphasis added.]

The Examiner concedes that the Patton patent fails to teach a bar code label. To compensate for this admitted deficiency of the Patton patent, the Examiner contends that (i) the bar code labels are well known in the art, and (ii) that one of ordinary skill in the art would have been

motivated to modify the Patton patent to include a bar code label for the purpose of making an automatic entry of information via a handheld scanner. (See Paper No. 6, page 10.)

The applicants respectfully disagree with the Examiner's conclusion as to motivation to modify. More specifically, the Examiner earlier contends that the Picons in the Patton patent teach the claimed label. (See Paper No. 6, page 3.) Picons are thumbnail images and are used to represent a plurality of images grouped together under a common theme. Thus, Picons are used as a visual cue to help users organize and retrieve images. Replacing Picons with bar code labels would destroy the utility of helping users to organize and retrieve images using visual cues. Clearly, one skilled in the art would not have been motivated to modify the Patton patent as proposed by the Examiner. Accordingly, claim 6 is not rendered obvious by the Patton patent for at least this reason. Since claims 11, 25 and 30 include a similar recitation, they are similarly not rendered obvious by the Patton patent.

Further, even assuming, arguendo, that one skilled in the art would have been motivated to replace Picons with bar code labels, this does not compensate for the deficiencies of the Patton patent with respect to the claims of Group I. Since claim 6 depends from claim 1 (and since claims 11, 25, and 30 depend from claims 10, 20 and 29, respectively), it is allowable for the reasons discussed above with reference to the claims of Group I. Further, since claims 11 and 30 depend from claims 10 and 29, respectively, these claims are not rendered obvious by the Patton patent for the reasons discussed above with reference to the claims of Group IV.

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Claims 3, 4 and 34 stand rejected under 35 U.S.C.
§ 103(a) as being unpatentable over the Patton patent in
view of the Yanagihara publication. The Appellant
respectfully requests that the Board reverse this rejection
in view of the following.

Group VIII: Claims 3, 4 and 34

Representative claim 3 is not rendered obvious by the
Patton patent and the Yanagihara publication because one
skilled in the art would not have been motivated to modify
the Patton patent in view of the Yanagihara publication as
proposed by the Examiner.

The Examiner concedes that the Patton patent fails to
disclose that the read/write machine is a personal
computer. To compensate for this admitted deficiency, the
Examiner (i) relies on the Yanagihara publication as
teaching a read/write machine being a personal computer,
and (ii) contends that it would have been obvious to modify
the Patton patent to include a personal computer to provide
a convenient means for editing, displaying and transporting
images over the Internet. (Paper No. 6, pages 11 and 12.)
The Appellant respectfully disagrees.

As shown in Figures 1-3, the Patton patent describes a
camera as the means for writing image data onto a disk.
Although the image data on the disk can be later
manipulated by other devices, the image data is written by
the camera. Clearly, one skilled in the art would not have
been motivated to include a personal computer in a camera.
Doing so might destroy portability features desirable in a
camera such as light weight, low battery consumption, not

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to mention low cost. Accordingly, claims 3, 4 and 34 are not rendered obvious by the Patton patent and Yanagihara publication for at least this reason.

Moreover, with respect to claim 34, the Examiner contends that element 16 of Figure 1 of the Yanagihara publication discloses means for synchronizing a database with a database maintained on a separate machine. (See Paper No. 6, page 12.) The cited reference is a DVD drive. It is unclear how the mere provision of a DVD drive teaches or suggests means for synchronizing a database with a database maintained on a separate machine. Accordingly, claim 34 is not rendered obvious by the Patton patent and Yanagihara publication for at least this additional reason.

Further, even assuming, arguendo, that one skilled in the art would have been motivated to include a personal computer in the camera of the Patton patent, this does not compensate for the deficiencies of the Patton patent with respect to claims 1 (and 29) discussed above. Since claims 3 and 4 include the features of claims 1 and 2 by virtue of their dependency, they are further not rendered obvious for the reasons discussed above with reference to the claims of Groups I and II. Since claim 34 includes the features of claims 20 and 29 by virtue of its dependency, these claims are not rendered obvious by the Patton and Yanagihara patents for the reasons discussed above with respect to the claims of Groups I and II.

Claims 17, 18, 37 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Patton patent in view of the Cathey publication. The Appellant respectfully requests that the Board reverse this rejection in view of the following.

Group IX: Claims 17, 18, 37 and 38

Representative claim 17 is not rendered obvious by the
Patton patent and the Cathey publication because it recites
that if the storage medium has not been assigned a unique
volume label and a unique label identifier then further,
(i) generating a label based on the unique label
identifier, and (ii) fixing the generated label to the
storage medium without storing it on the storage medium.
Claim 17 is reprinted below with this feature depicted in
bold typeface:

> 17.   The method of claim 16 further
> comprising:
>> g)   **if the accepted information
>> read from the machine-readable
>> labels does not match information
>> associated with any one of the one
>> or more records accepted, then
>> generating a second indicator,
>> said second indicator able to be
>> perceived by humans.**   [Emphasis
>> added.]

The Examiner concedes that the Patton patent does not
teach that if the storage medium has not been assigned a
unique volume label and a unique label identifier then
further, (i) generating a label based on the unique label
identifier, and (ii) fixing the generated label to the
storage medium without storing it on the storage medium.   .
The Examiner relies on the Cathey publication to compensate
for this admitted deficiency.   More specifically, the
Examiner contends that paragraph 10 of the Cathey
publication teaches this.   (See Paper No. 6, page 13.)

This paragraph concerns providing a visible or audible warning that notifies a user of a low battery condition in a pager/cellphone device. This clearly does not compensate for the admitted deficiency of the Patton patent with respect to claim 17. Accordingly, claim 17 is not rendered obvious by the Patton patent and the Cathey publication for at least this reason. Since claim 37 includes a similar recitation, and since claims 18 and 38 depend from claims 17 and 37, respectively, these claims are similarly not rendered obvious by the Patton patent and the Cathey publication.

Further, this purported teaching of the Cathey publication does not compensate for the deficiencies of the Patton patent with respect to claims 15 and 35 discussed above. Since claims 17 and 18 include the features of claim 15 by virtue of their dependency, and since claims 37 and 38 include the features of claim 35 by virtue of their dependency, these claims are not rendered obvious by the Patton patent and the Cathey publication for at least the reasons discussed above with reference to the claims of Group V.

IX. Appendix

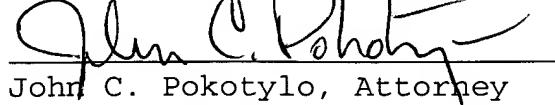An appendix containing a copy of the claims on appeal is filed herewith.

Conclusion

In view of the foregoing, the Appellant respectfully submits that the pending claims are in condition for

allowance. Accordingly, the Appellant requests that the
Board reverse each of the outstanding grounds of rejection.

Respectfully submitted,

November 10, 2004

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John C. Pokotylo

November 9, 2004
Date

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APPENDIX

1   Claim 1 (previously presented): For use by a read/write
2   machine, a method for assigning a unique label to a storage
3   medium, the method comprising:
4   a)   determining whether or not the storage medium has
5   been assigned a unique volume label and a unique label
6   identifier;
7   b)   if the storage medium has not been assigned a
8   unique volume label and a unique label identifier,
9   then
10   (i)   determining a unique label identifier for
11   the storage medium,
12   (ii)   determining a unique volume label for the
13   storage medium,
14   (iii)   writing the unique volume label onto the
15   storage medium, and
16   (iv)   providing a command to generate a label
17   based on the unique label identifier, the label
18   to be associated with the storage medium; and
19   c)   updating a database based on files, if any, added
20   to or deleted from the storage medium.

1   Claim 2 (original): The method of claim 1 further
2   comprising:
3   d)   synchronizing the database with a database on a
4   device apart from the read/write machine.

1   Claim 3 (original): The method of claim 2 wherein the
2   read/write machine is a personal computer and the device is
3   a handheld device.

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1 Claim 4 (original): The method of claim 3 wherein the
2 device is an untethered handheld device.

1 Claim 5 (original): The method of claim 1 wherein the
2 read/write machine is a computer with at least one of (a) a
3 floppy disk drive, (b) a CD ROM drive, (c) a ZIP drive, and
4 (d) a DVD drive.

1 Claim 6 (original): The method of claim 1 wherein the
2 label based on the unique label identifier is a bar code
3 label.

1 Claim 7 (original): The method of claim 1 wherein the act
2 of determining a unique volume label is based, at least in
3 part, on state information accessible to the read/write
4 machine.

1 Claim 8 (original): The method of claim 7 wherein the
2 state information is a count sequence.

1 Claim 9 (original): The method of claim 1 wherein the
2 database includes records, each record including a first
3 field having a value associated with the unique volume
4 label, and a second field having a value associated with a
5 file stored on the storage medium.

1 Claim 10 (previously presented): The method of claim 1,
2 further comprising:
3   d) accepting information read from a label associated
4   with the storage medium without reading the storage
5   medium;

6   e)   converting the accepted information into a

7   database key;

8   f)   requesting records from a database instance using

9   the database key;

10   g)   accepting records in response to the request; and

11   h)   rendering information about the accepted records.

1   Claim 11 (original): The method of claim 10 wherein the

2   label associated with the storage medium is a bar code and

3   wherein the information read from the label is accepted

4   from a bar code scanner.

1   Claim 12 (original): The method of claim 10 wherein the

2   information about the accepted records rendered includes

3   file names.

1   Claim 13 (original): The method of claim 12 wherein the

2   accepted information read from a label associated with the

3   storage medium is read by a handheld device, and the

4   information about the accepted records is rendered on the

5   handheld device.

1   Claim 14 (original): The method of claim 13 wherein the

2   read label is converted into a database key by the handheld

3   device, the records are requested from a database instance

4   using the database key by the handheld device, and the

5   records are accepted in response to the request by the

6   handheld device.

1   Claim 15 (previously presented): A method for matching

2   file parameters with one or more storage media, each of the

3   one or more storage media having an associated label, the

4   method comprising:

5   a)   accepting one or more search parameters;

6   b)   generating a query based on the search parameters;

7   c)   accepting one or more records returned in response to

8   the query generated;

9   d)   rendering information associated with each of the one

10   or more records accepted, the information rendered being

11   related to the label associated with the storage medium

12   storing one or more files identified with the one or more

13   records accepted, wherein the label is provided on the

14   storage medium without storing it on the storage medium.

1   Claim 16 (original):   The method of claim 15 wherein the

2   labels are machine-readable labels, the method further

3   comprising:

4   e)   accepting information read from the

5   machine-readable labels;

6   f)   if the accepted information read from the

7   machine-readable labels matches information associated

8   with any one of the one or more records accepted, then

9   generating a first indicator, said first indicator

10   able to be perceived by humans.

1   Claim 17 (original):   The method of claim 16 further

2   comprising:

3   g)   if the accepted information read from the

4   machine-readable labels does not match information

5   associated with any one of the one or more records

4

6   accepted, then generating a second indicator, said second

7   indicator able to be perceived by humans.

1   Claim 18 (original): The method of claim 17 wherein the

2   first indicator is a first audible sound, and the second

3   indicator is a second audible sound.

1   Claim 19 (original): The method of claim 15 wherein each

2   of the labels include human-readable part, and wherein the

3   information associated with each of the one or more records

4   accepted corresponds to the human-readable part of the

5   labels.

1   Claim 20 (previously presented): An apparatus for

2   assigning a unique label to a removable storage medium, the

3   apparatus comprising:

4   a)   means for reading files from and/or writing files

5   to a removable storage medium;

6   b)   means for generating a label;

7   c)   means for determining whether or not the removable

8   storage medium has been assigned a unique volume label

9   and a unique label identifier;

10   d)   means, if the storage medium has not been assigned

11   a unique volume label and a unique label identifier,

12   for

13   (i)   determining a unique label identifier,

14   (ii) determining a unique volume label,

15   (iii) instructing the means for reading and/or

16   writing files to write the unique volume label

17   onto the storage medium, and

18   (iv)   providing a command to generate a label

19   based on the unique label identifier, to the

20   means for generating a label; and

21   e)   a database, wherein the database is updated based

22   on any files added to or deleted from the removable

23   storage medium.

1   Claim 21 (original):   The apparatus of claim 20 further

2   comprising:

3   f)   means for synchronizing the database with a

4   database on a device apart from the apparatus.

1   Claim 22 (original):   The apparatus of claim 21 wherein the

2   device is a handheld device.

1   Claim 23 (original):   The apparatus of claim 21 wherein the

2   device is an untethered, handheld device.

1   Claim 24 (original):   The apparatus of claim 20 wherein the

2   means for reading files from and/or writing files to a

3   removable storage medium are at least one of (a) a floppy

4   disk drive, (b) a CD ROM drive, (c) a ZIP drive, and (d) a

5   DVD drive.

1   Claim 25 (original):   The apparatus of claim 20 wherein the

2   label is a bar code label.

1   Claim 26 (original):   The apparatus of claim 20 further

2   comprising:

3   f) state information, wherein the unique volume label

4   is determined, at least in part, based on the state

5   information.

1 Claim 27 (original): The apparatus of claim 26 wherein the

2 state information is a count sequence.

1 Claim 28 (original): The apparatus of claim 20 wherein the

2 database includes records, each record including a first

3 field having a value associated with the unique volume

4 label, and a second field having a value associated with a

5 file stored on the removable storage medium.

1 Claim 29 (previously presented): The apparatus of claim 20

2 further comprising:

3   f) means for reading a label associated with the

4   storage medium without reading the storage medium;

5   g) means for accepting information read, by the means

6   for reading, from a label associated with the storage

7   medium;

8   h) means for converting the read label into a

9   database key;

10   i) means for requesting records from a database

11   instance using the database key;

12   j) means for accepting records in response to the

13   request; and

14   k) means for rendering information about the accepted

15   records.

1 Claim 30 (original): The apparatus of claim 29 wherein the
2 means for reading is a bar code scanner, and wherein the
3 label associated with the storage medium is a bar code.

1 Claim 31 (original): The apparatus of claim 29 wherein the
2 information about the accepted records rendered includes
3 file names.

1 Claim 32 (original): The apparatus of claim 29 wherein the
2 means for rendering is a display.

1 Claim 33 (previously presented): The apparatus of claim 29
2 further comprising:
3   1) the database.

1 Claim 34 (previously presented): The apparatus of claim 33
2 further comprising:
3   m) means for synchronizing the database with a
4   database maintained by a separate machine which
5   created the storage medium.

1 Claim 35 (previously presented): An apparatus for matching
2 file parameters with one or more storage media, each of the
3 one or more storage media having an associated label, the
4 apparatus comprising:
5   a) a user input for accepting one or more search
6   parameters;
7   b) means for generating a query based on the accepted
8   one or more search parameters;
9   c) means for accepting one or more records returned in
10   response to the query generated;

11 d) means for rendering information associated with each
12   of the one or more records accepted, the information
13   rendered being related to the label associated with the
14   storage medium storing one or more files identified with
15   the one or more records accepted, wherein the label is
16   provided on the storage medium without storing it on the
17   storage medium.

1 Claim 36 (original): The apparatus of claim 35 wherein the
2 labels are machine-readable labels, the apparatus further
3 comprising:
4   e) a label reader for reading information read from
5   the machine-readable labels; and
6   f) an output means for generating a first indicator
7   able to be perceived by humans if the accepted
8   information read from the machine-readable labels
9   matches information associated with any one of the one
10   or more records accepted.

1 Claim 37 (original): The apparatus of claim 36 wherein the
2 output means further generates a second indicator able to
3 be perceived by humans if the accepted information read
4 from the machine-readable labels does not match information
5 associated with any one of the one or more records
6 accepted.

1 Claim 38 (original): The apparatus of claim 37 wherein the
2 output means is a speaker, wherein the first indicator is a
3 first audible sound, and wherein the second indicator is a
4 second audible sound.

1   Claim 39 (original): The apparatus of claim 35 wherein

2   each of the labels include human-readable part, and wherein

3   the information associated with each of the one or more

4   records accepted corresponds to the human-readable part of

5   the labels.

1   Claim 40 (previously presented): The method of claim 1

2   wherein if the storage medium has not been assigned a

3   unique volume label and a unique label identifier then

4   further,

5   - generating a label based on the unique label

6   identifier, and

7   - fixing the generated label to the storage

8   medium without storing it on the storage medium.

1   Claim 41 (previously presented): The apparatus of claim 20

2   further comprising means, if the storage medium has not

3   been assigned a unique volume label and a unique label

4   identifier, for

5   - generating a label based on the unique label

6   identifier, and

7   - fixing the generated label to the storage

8   medium without storing it on the storage medium.